

Serial No. 09/546,833**PATENT****Docket No. RAL920000042US1****REMARKS**

This amendment is in response to the Office Action mailed January 9, 2004.

Claims 8-18 stand allowed and are not discussed further in this document.

Claims 4 and 7 are objected to. The Examiner did not articulate what the objection is in the Office Action. However, applicants assume that they are objected to because they depend on rejected base claims. With this assumption claims 4 and 7 are rewritten in independent form and are believed to be allowable and will not be discussed further in this document. However, if applicants assumption is incorrect it is requested that the Examiner issue a supplemental office action (non-final) articulating the reason for the objection and give applicants an opportunity to amend the claims as required by the Examiner.

Claims 1, 3, 6, 19 and 20 are rejected under 35 USC 102(e) as being anticipated by Tappan (U.S. Patent 6,295,296).

Before addressing the rejection the law as it applies to anticipation is stated. Claims in a patent application can only be anticipated if every element recited in the claim is found explicitly or inherently in a single reference. In responding to the Office Action the claims are amended to state that the header contains code that is used by the egress processor to select the beginning address in the picocode instruction where the egress processor begins processing. In contrast, Tappan teaches an upstream router searches its routing table to determine where a packet is to be routed. In doing so it extracts routing information which is inserted in a shim header and forwarded to a downstream router which uses the information for further routing

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(see Tappan Fig.4, col. 5, lines 50-67). The teaching in Tappan does not provide information which is used to select the point in the microcode instruction as is done and recited in the amended claims. As a consequence the invention in Tappan and that which is claimed in the present application are different inventions. Therefore, Tappan reference does not anticipate the amended claims.

Claims 2 and 5 depend on the amended claim 1 and are patentable over the art of record in that they now provide a novel method, i.e. selecting beginning point in the microcode of a processor, coupled with benefits (quicker throughput) as set forth in the specification. It is applicants' contention that novel process steps together with benefits are indicia of unobviousness. As a consequence claims 2 and 5 are patentable over the art of record.

Newly added claim 21 is also patentable over the art of record for reasons set forth above and in addition that the ingress processor inserts data in the header which is used by the egress processor as is required by the picocode instruction. This feature is not suggested or disclosed in any of the references. Therefore, claim 21 is separately patentable.

Claim 22 is essentially a rewrite of claim 2 depending on the unamended claim 1. The Examiner had rejected claim 2 under 35 USC 103 as being unpatentable in view of Tappan. Even though the Examiner admits at page 3 of the Office Action that Tappan did not show or teach the insertion of control information in the header that distinguishes frames as being unicast or multicast to the egress router the Examiner concludes that it would be obvious for one skilled in the art to modify Tappan to meet the terms of claim 2 now newly submitted claim 22.

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In response, applicants respectfully disagree with the Examiner and argue that Tappan failed to suggest any reason or motivation for the modification which the Examiner proposes. The Examiner on the other hand has not given any concrete reason why an artisan viewing the teaching in Tappan would make the modification when Tappan is silent and does not suggest reason for the modification. The Examiner is obligated to present a prima facie case of obviousness. It is applicants' contention that the Examiner has not. Therefore, claim 21 is patentable over the art of record.

Regarding claim 23 the claims specifically calls for a single bit in the header to indicate unicast or multicast. It is noted that none of the references even suggest including multicast/unicast information in the header much less to teach the use of a single bit. By using a single bit the amount of data transmitted is much less and the throughput of the system is enhanced. As a consequence a novel method together with benefits (quicker processing) are indicia of unobviousness. Therefore, claim 23 is patentable over the art of record.

Regarding claim 24 it is essentially a rewrite of the rejected claim 5 and unamended claim 1. Regarding claim 5 the Examiner formed a combination of Tappan and Brunner (U.S. Patent 5,982,775) to reject claim 5.

In response, applicants respectfully disagree with the Examiner and argue the rejection improper in that there is no motivation to form the Examiner's combination. The Examiner is not permitted to pick and choose elements from different references and combine them without suggestion or logical reasons why an artisan viewing the art would make the combination. To do so is an indication of hindsight obtained solely

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from the teaching of the present invention rather than foresight of one skilled in the art. This approach (hindsight) cannot be used to render applicants' invention unpatentable.

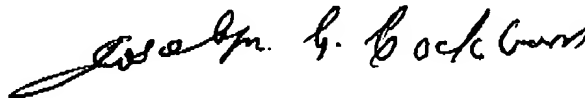
"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". W.L. Gore, 721 F.2d at 1553, 220 USPQ pp312-313 (Fed Cir. 1983).

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention" In re Fine, 5 USPQ F.2d 1596 (C.A.F.C.) 1988.

In view of the above it is applicants' contention claim 24 is patentable over the art of record.

It is believed that the present amendment answers all the issues raised by the Examiner. Reconsideration is respectfully requested and an early allowance of all the claims is solicited.

Respectfully Submitted,



Joscelyn G. Cockburn, Reg. No. 27,069
Attorney of Record
Customer No. 25299

JGC:ko
Phone: 919-543-9036
FAX: 919-254-2649

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